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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,570	11/08/2001	Jin Po Lee	086748-20	7953
46725	7590	01/09/2006	EXAMINER	
BERND W. SANDT 900 DEERFIELD COURT MIDLAND, MI 48640			ALEXANDER, LYLE	
			ART UNIT	PAPER NUMBER
			1743	
DATE MAILED: 01/09/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/019,570  
Filing Date: November 08, 2001  
Appellant(s): LEE, JIN PO

**MAILED**  
JAN 09 2006  
**GROUP 1700**

\_\_\_\_\_  
Mr. Bernd W. Sandt  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 10/21/05 appealing from the Office action mailed 10/21/05.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

**(2) Related Appeals and Interferences**

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows: The Obviousness-type Double Patenting rejection of claims 10-19 in the final Office action of 11/26/04 will be maintained. The 2/15/05 terminal disclaimer by Appellant has a typographical error in referencing the application being disclaimed. The disclaimer disclaims "09/314,277"

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which does not belong to Appellant. The disclaimer should have disclaimed – 09/364,277--. The Office regrets that the 7/27/05 approval of the 2/15/05 disclaimer was in error.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

5,770,458

Klimov et al.

6-1998

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 10-19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,514,769. Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed to a test device having a base with adjacent slots to a separate each of a of test strips.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 10-19 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Klimov et al.

Klimov et al. teach an assay device comprising a plastic holder (102) for insertion of the test membranes (101). The holder (102) has plurality of slots for different test membranes (101). Each membrane (101) has a test zone (103) and a control site

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(104). Figures 1A-1B illustrate that each slot is defined by a floor, raised wall and open end to receive the sample. Column 10 lines 32-57 state each slot is sealed with cover panel (115) to prevent leakage. Column 10 lines 39-41 teach the sample contacts the membranes (101) via sample pads (109) through holes on the backside. Columns 5-6 lines 64-4 respectively teach a cup is employed to collect the sample from the top of the cup and interact with the holder (102) to facilitate transfer of sample to the membranes (101) [also see figure 1C]. Column 7 lines 7-12 teach the analytes of interest that include the claimed drugs of abuse. Result windows (113) and (114) are transparent.

The claimed base has been read on the taught holder (102), the claimed test strips on the taught membrane (10), the claimed cover on the taught cover panel (115), the claimed sample port on the taught sample pads (109) through holes on the back side and the claimed floor opposing the sample port on the taught cup.

#### **(10) Response to Argument**

Appellant's argue that Improve et al. fail to teach slots in a housing for the assay strips with walls between the slots, strips that extend beyond the housing and a cover.

Klimov et al. teach in column 10 each test membrane is subject to a different test and sealing is required to prevent leakage. Figures 1A-C also shows the different channels. Finally column 10 lines 24-27 state the plastic holder (102) can be that of US patent application 08/122,227, now USP 5,403,551, which is incorporated by reference. USP 5,403,551 teaches illustrates in column 5 lines 5+ a plurality of longitudinal ribs (78) spacing the strips apart. The Office maintains Kimrov et al. teach longitudinal ribs (78) that have been read on the claimed "raised walls".

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Klimov et al. teach the sample pad (109) extends beyond the cover (115) to the upper portion of the sample cup, which has been read on the claimed limitation of the strips extending beyond the cover.

Klimov et al. teaches cover (115) which has been read on the claimed cover.

For the above reasons, it is believed that the rejections should be sustained.

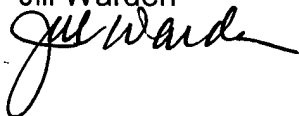
Respectfully submitted,

Lyle A. Alexander

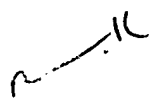


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